OIPE
AUG 03 2006
PATENT & TRADEMARK OFFICE

AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Bret BERRY, et al.	§	Docket No.:	31132.118
Serial No.:	10/691,256	§	Examiner:	Alvin J. Stewart
Filed:	October 22, 2003	§	Art Unit:	3738
For:	Vertebral Body Replacement Implant	§	Conf. No.:	5450

TRANSMITTAL

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed for filing in the above-identified patent application.

1. Notice of Appeal;
2. Pre-Appeal Brief Request for Review;
3. Check in the amount of $500.00; and
4. Return postcard.

The Director is authorized to charge any deficiency fees or credit any overpayments associated with this communication to Deposit Account No. 08-1394 of Haynes and Boone, LLP.

Respectfully submitted,

David M. O'Dell
Registration No. 42,044

Date: 7-31-06

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972-739-8635
Facsimile: 214-200-0853

File: 31132.118

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on 7-31-06

Bonnie Boyle

Signature of person mailing paper and fee

OIPE IAP19
AUG 0 3 2006
PATENT & TRADEMARK OFFICE

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
31132.118	

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 7-31-06

Signature Bonnie Boyle

Typed or printed name Bonnie Boyle

Application Number	Filed
10/691,256	October 22, 2003

First Named Inventor: Bret BERRY, et al.

Art Unit	Examiner
3738	Alvin J. Stewart

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 42,044.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

David M. O'Dell
Typed or printed name

(972) 739-8635
Telephone number

July 31, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

REASONS

In the Final Office Action mailed May 4, 2006, claims 24-34, 40-44, 46-53, 55, and 62-67 were pending and under consideration. Claims 27, 28, 30, 63 were objected to as being dependent upon a rejected base claim, but were indicated as being allowable if rewritten in independent form. No indication of allowance or rejection was issued with respect to claims 64 and 55. Claims 24-26, 29, 31-34, 40-44, 46-53, 62, and 65-67 were rejected. It is respectfully submitted that there are clear errors with the Examiner's rejections.

Rejections Under Schafer

Independent claims 24-26, 29, 31-34, 40-43, 46-53, 62, 65, and 66 stand rejected under 35 U.S.C. §102(b) as being anticipated by Schafer (2004/0172129). However, these rejections have clear legal deficiencies because the asserted prior art lacks essential elements needed to establish a prima facie rejection.

The PTO specifies in MPEP §2131 that, to anticipate a claim, a reference must teach each and every element recited in the claim. However, with respect to independent claim 24 Schafer does not disclose "a basket comprising a tubular wall bounded by a base, the wall and base defining a cavity," as recited. The Final Office Action pointed to the locking element 42 in Schafer as being the equivalent to the basket of claim 24. As seen best in Fig. 9 of Schafer (reproduced below), the locking element 42 is clearly not a basket.

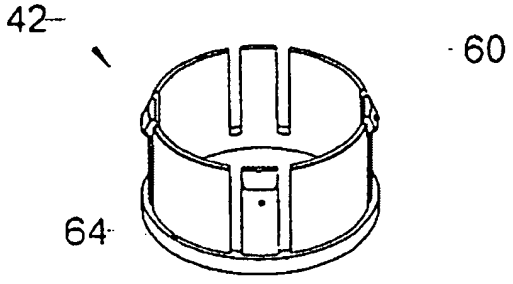


Fig. 9

Further, the locking element 42 clearly does not teach the claimed structural limitations of the basket: "a tubular wall bounded by a base, the wall and base defining a cavity." The locking element 42 is simply not bounded by a base as expressly required by claim 24. There is clear

error in considering the locking element 42 of Schafer as sufficient to teach the basket as recited in claim 24. Claims 25, 26, 29, 31-34, 62, and 63 depend from and further limit claim 24. Applicants have therefore shown clear legal deficiency in the rejection of claims 24-26, 29, 31-34, 62, and 63. Consequently, these rejections are clearly not proper, are without basis, and should be withdrawn.

Independent claims 40, 46, and 65 contain limitations similar to that recited above with respect to independent claim 24. Claim 40 recites in part, "a sidewall circumscribing a base; an open end opposite the base;" claim 46 recites in part, "a graft containment device, comprising an open end and a perforated base plate opposite the open end;" and claim 65 recites in part, "a tubular receptacle member ..., the tubular receptacle member bounded at one end by a perforated base to form a cavity." As shown above, the locking element 42 simply does not teach "a sidewall circumscribing a base," "a perforated base plate opposite the open end," or "the tubular receptacle member bounded at one end by a perforated base" as expressly required by claims 40, 46, and 65, respectively. There is clear error in considering the locking element 42 of Schafer as sufficient to teach these elements. Claims 41-44, 47-53, 66, and 67 depend from and further limit claims 40, 46, and 65. Applicants have therefore shown clear legal deficiency in the rejection of claims 40-44, 46-53, and 65-67. Consequently, these rejections are clearly not proper, are without basis, and should be withdrawn as well.

Rejections Under Malone

Claims 40-44, 65, and 67 stand rejected under 35 U.S.C. §102(b) as being anticipated by Malone (2002/0169507). However, these rejections have clear legal deficiencies because the asserted prior art lacks essential elements needed to establish a prima facie rejection.

With respect to independent claim 40, Malone simply does not disclose "an engagement device for maintaining the graft containment device within the cavity of the corpectomy device." Malone does not teach a graft containment device for use with a corpectomy device. Rather, Malone involves the use of interbody spinal fusion cages. There is clear error in considering the interbody cages of Malone as sufficient to teach the use of a graft containment device with a corpectomy device. Claims 41-44 depend from and further limit claim 40. Applicants have therefore shown clear legal deficiency in the rejection of claims 40-44. Consequently, these rejections are clearly not proper, are without basis, and should be withdrawn.

With respect to independent claim 65, Malone does not disclose "a first tubular implant member having a longitudinal axis extending substantially parallel to the spinal column." Rather, the longitudinal axis 30 in Malone extends substantially perpendicular to the spinal column, as shown in Fig. 1 of Malone. Further, Malone does not disclose "a tubular receptacle member ..., the tubular receptacle member bounded at one end by a perforated base to form a cavity." Malone simply does not disclose tubular member bounded by a perforated base. Thus, for at least these reasons there is clear error in relying on Malone to teach the claimed elements of claim 65. Claim 67 depends from and further limits claim 65. Applicants have therefore shown clear legal deficiency in the rejection of claims 65 and 67. Consequently, these rejections are clearly not proper, are without basis, and should be withdrawn.

Rejections Under Kojimoto

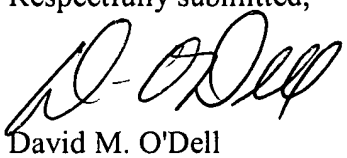
Independent claim 46 stands rejected under 35 U.S.C. §102(b) as being anticipated by Kojimoto (5,290,312). However, this rejection has clear legal deficiencies because the asserted prior art lacks essential elements needed to establish a prima facie rejection.

In particular, Kojimoto simply fails to disclose "an expandable tubular assembly having a sidewall; and a graft containment device," as recited by claim 46. Rather, depending on how one characterizes the components of the Kojimoto reference, Kojimoto discloses either an expandable assembly and no graft containment device, or a graft containment device and no expandable assembly. Kojimoto simply fails to teach an expandable tubular assembly and a graft containment device. If component 18 of Kojimoto is considered a graft containment device as asserted by the Final Office Action, then there cannot be an expandable tubular assembly because component 20 is clearly not expandable. Similarly, if the two components 18, 20 are considered together to be an expandable assembly, then there cannot be a graft containment device because there are no other components. There is clear error in considering the components 18 and 20 of Kojimoto as sufficient to teach an expandable tubular assembly and a graft containment device, as required by claim 46. Claims 47-53 depend from and further limit claim 46. Applicants have therefore shown clear legal deficiency in the rejection of claims 46-53. Consequently, these rejections are clearly not proper, are without basis, and should be withdrawn.

Conclusion

Thus, Applicants have therefore shown clear legal deficiency in all of the Examiner's rejections. The rejections are clearly not proper and are without basis. It is therefore respectfully requested that the rejections be withdrawn.

Respectfully submitted,



David M. O'Dell
Registration No. 42,044

Date: July 31, 2006

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: (972) 739-8635
Facsimile: (214) 200-0853
File: 31132.118

R-140172.1